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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/840,166	04/24/2001	Katsuhisa Ogawa	35.C15320	3421
5514 7590 02/09/2007 FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			EXAMINER JANVIER, JEAN D	
			ART UNIT	PAPER NUMBER
			3622	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/09/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

09/840,166

Applicant(s)

OGAWA ET AL.

Examiner

Jean Janvier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 15-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

**Detailed Action**

**Specification**

**Status of the claims**

Claims 1-26 are currently pending in the Application. Claims 1-14 are herein being examined after an election without traverse, while claims 15-26 are being withdrawn from further consideration. Applicant should cancel the withdrawn claims in a future correspondence. Thus, the restriction requirement has been made final.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Ishijima, US 6,882,439B2.

As per claims 1-14, Ishijima discloses a system that relates to a printing service for discounting services for a user, by including advertisements into the user's printed documents, and realizes various discount services. The present system comprises a printing step for sending printing management information (print point) along with the user ID to a server through a network when the user prints with advertisements using the user's printing device 2 and storing that information as an advertisement usage record (print point) for each user ID, a step for referencing the user's advertisement usage record, for least one service selected by the user from among a plurality of services, relating to the printing device that used the advertisement printing record, determining whether to authorize the discount for the selected service and updating the advertisement usage record (updating the user's print point) of the user to perform the authorized discount service. A variety of discount services can be realized because the print operation with advertisements is managed by the server and the user can use the usage records (See the abstract).

In general, the present system is configured to provide a printing usage service and a printer that enables a user to receive a preferred discount service, such as discounted toners/ink cartridges and printing papers, through the printing of advertisements inserted into the user's documents. Here, the user receives discount points for printing with advertisements and the points can be redeemed to purchase toners and papers at discounted prices.

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Printing management information is transferred from the printing device to a server and the server manages advertisement usage records each time advertisements are printed with the printing device. Then, the server references the advertisement usage records and authorizes the service relating to the printing device selected by the user. For this reason, because the server manages this system with the advertisement usage records, the user can select a plurality of services provided by the server and receive discounted service. Also, because the server manages the printing of advertisements, the process for billing the advertiser also becomes easy.

Further, the printing step preferably comprises: a step of sending the printing management information to the server with said printer; a step of calculating the advertisement usage records for the user from the printing management information, compiling the advertisement usage records, and transferring the advertisement information to the printing device; and a step of combining the advertisement images with the printing information to be printed based on the advertisement information from the server and printing out by the printing device. Thus, after the advertisement usage records have been compiled, the printing of advertisements is executed, meaning that it is possible to accurately manage the advertisement usage records with the server. Meanwhile, the user information, separated in the discount points information, is calculated and stored in the user data table 10, for that user ID, based on the number of pages printed and the size of the advertisements. Also, the cumulative reference count in the reference count table 12 is updated.

Col. 1: 60 to col. 3: 20.

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In one embodiment, the actual service can be selected by the user from among a plurality of services in addition to discounting the bills, such as discounting paper fees, ink and toner fees, cartridge fees, discounting maintenance fees and appropriations (providing expendable supplies to the user using the user's stored points). The number of discount points used by the user, as described above, is determined by the service requested by the user. In effect, the services may be worth the same or different numbers of points. (Col. 7: 64 to col. 8: 8). For example, FIG. 17 shows the flow in the case where a request is made by the user for a toner cartridge 22 for the printer 2. The user makes a request for the toner cartridge 22 from the terminal 1 to the host 4. On the host side 4, the toner cartridge 22 is discounted by reference to the discount points with the user ID and a toner cartridge 22 is sent to the user (determining whether expendable supplies or discounted printing supplies, such as toners or papers, should be provided to the user based on the printed advertising record (print point) received by the server or host computer from the user's printing device and based on the number of discount points accumulated under the user's account or ID for printing with advertisements as featured in received advertising record/print point) (Col. 10: 27 to col. 11: 10).

See in general Col. 6: 37-46; col. 6: 47 to col. 7: 27.

### **Response To Applicant's Arguments**

In general, Applicant's arguments are moot in view of new grounds of rejection.

Further, regarding the IDS issue, although the Applicant refers to an IDS filed with Application 09/840,103, however, the Examiner notes that the Application is not directly related

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to the Instant Application and it is being assigned to a different Examiner and thus, a separate IDS should be provided for the Instant Application.

Additionally, regarding the foreign priority claim, although the Examiner herein acknowledges a foreign priority claim in this Application, however, the priority claim cannot be perfected at this time for no English translation of the certified document or priority document was submitted and hence, the reference, as recorded above, becomes a valid prior art until the Applicant perfects the priority claim by providing an English copy of the priority document.

**“2304.01(c) [R-4] Translation of Foreign Benefit Application**

**A certified “English” translation of every foreign benefit application or Patent Cooperation Treaty (PCT) application not filed in English is required.** 35 U.S.C. 119(b)(3) and 372(b)(3) and 37 CFR 1.55(a)(4). If no certified translation is in the official record for the application, the examiner must require the applicant to file a certified translation. The applicant should provide the required translation if applicant wants the application to be accorded benefit of the non-English language application. Any showing of priority that relies on a non-English language application is prima facie insufficient if no certified translation of the application is on file. 37 CFR 41.154(b) and 41.202(e)”.

**Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

USP 5,383,129 to Farrell discloses There is provided a method of estimating cost of printing materials used to print a job on a printing apparatus. The method includes the steps of:

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storing billing rates reflecting the cost of printing materials to be used in printing the job, selecting a first quantity of printing materials to be used in printing the job, and, prior to printing the job, calculating, as a function of the first selected quantity of printing materials and one of the stored billing rates, a first printing materials cost of the job.

USP 6,025,925 to Davidson discloses an improved printing system having at least one host computer and a printer in which the printer acquires print job accounting information and communicates it to the host computer via NPAP messages. A host computer downloads print job data to the printer through a communications port on the printer (i.e., either a parallel port, serial port, or network port), and as the printer prints the print job that it received from the host computer, the printer temporarily stores job accounting information. At the end of the print job, the printer communicates that job accounting information back to armed host computers via a bi-directional communications port, including typical information such as: the job identifier number, job processing time, number of sheets of paper from each paper source, number of impressions from each paper source (either one-sided or two-sided impressions), the port identifier, the network user name, the name of the print job (as specified), and the printer's serial number. Since the data is being accumulated at the printer, rather than at the host computer, there is no estimating by a host-resident program to acquire these statistics, and no database merging (from several host computers) is required to categorize all of the data for one particular printer. Furthermore, the print jobs need not pass through a network queue in order to be detected and accounted for.

USP 5,802,420 to Garr discloses an improved printer that predicts how many pages can be printed before the toner or ink cartridge becomes empty and also predicts how much time

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remains before this toner or ink cartridge becomes empty. This prediction is based upon the previous printing history of the printer while using this particular toner cartridge. After measuring the quantity of toner left in the toner cartridge, the printer of the present invention will display the approximate quantity of toner remaining in the cartridge on a screen of a host computer that is connected to the printer, either directly or through a network. The monitor screen of the host computer can also display the predicted number of pages remaining, based on the printer's previous usage history as described above. The toner measuring device provides a "level change" output signal when the remaining toner passes through a predetermined gradation threshold, and depending upon the size of the toner cartridge and upon the time and date at which the level change was detected, the predicted number of pages remaining and the actual amount of toner remaining are more accurately updated upon reaching one of these predetermined gradation thresholds. As each gradation level transition occurs, the printer calculates a new value for the "pages per gradation" variable, and also calculates the number of pages that have been printed since the latest cartridge was installed in the printer, the number of pages printed since the last level or gradation change, and the number of pages or sheets printed between the last two level changes. The printer also can approximate the amount of toner used in printing a particular page of print media to create a Toner Tally for each printed page, which can be used to judge the amount of toner used for one print job and compare that to the amount of toner used for a second print job. The Toner Tally uses a combination hardware/software counter to count the number of "active" pels of each page for a print job.

Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (571) 272-6719. The aforementioned can normally

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be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (571) 272- 6724.

Non-Official- 571-273-6719.

Official Draft : 571-273-8300

02/03/07

**JDJ**

**Jean D. Janvier**

**Patent Examiner**

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JEAN D. JANVIER  
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to read "Jean D. Janvier", written over the printed name and title.